

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

HERON THERAPEUTICS, INC.,

Plaintiff,

v.

C.A. No. 22-985-WCB

FRESENIUS KABI USA, LLC,

Defendant.

STIPULATION AND [PROPOSED] ORDER DISMISSING CERTAIN PATENTS

Pursuant to Federal Rule of Civil Procedure 41, Plaintiff Heron Therapeutics, Inc. (“Heron”) and Defendant Fresenius Kabi USA, LLC (“Fresenius”) hereby stipulate as follows:

WHEREAS, Heron sued Fresenius in this action (“Action”) for infringement under 35 U.S.C. § 271(e)(2) of, *inter alia*, U.S. Patent Nos. 9,808,465 (“the ’465 patent”); 9,973,793 (“the ’793 patent”); 10,500,208 (“the ’208 patent”); and 10,953,018 (“the ’018 patent”), based on Fresenius’s submission to the United States Food and Drug Administration of Abbreviated New Drug Application (“ANDA”) No. 214639 seeking approval to engage in the commercial manufacture, use, sale, or offer for sale of an injectable emulsion containing 130 mg/18 mL (7.2 mg/mL) aprepitant as described in said ANDA (“Fresenius’s ANDA Product”);

WHEREAS, Fresenius filed counterclaims in this Action for noninfringement and invalidity of the ’465 patent, the ’793 patent, the ’208 patent, and the ’018 patent; and the parties have completed their written discovery responses and document productions;

NOW THEREFORE, Heron and Fresenius, by their undersigned counsel, and subject to the approval of the Court, STIPULATE as follows:

1. Pursuant to Federal Rule of Civil Procedure 41(a)(2), Heron hereby dismisses without prejudice its claims that Fresenius's ANDA Product infringes any claims of the '465 patent, the '793 patent, the '208 patent, and the '018 patent under 35 U.S.C. § 271(e)(2).

2. Pursuant to Federal Rule of Civil Procedure 41(a)(2) and 41(c), Fresenius hereby dismisses without prejudice its counterclaims against all claims of the '465 patent, the '793 patent, the '208 patent, and the '018 patent.

3. All claims asserted by Heron with respect to patents other than the '465 patent, the '793 patent, the '208 patent, and the '018 patent, and those dismissed by prior Order entered in this case (D.I. 40), shall continue in this Action. For the avoidance of doubt, this Order shall not dismiss any claims from U.S. Patent Nos. 9,561,229 or 9,974,794.

4. Each party shall bear its own costs, expenses, and attorneys' fees incurred in connection with the claims dismissed by this Order.

5. The Court retains jurisdiction over the parties to this Action for purposes of enforcing this Stipulation and Order.

6. This Stipulation and Order shall not act as an adjudication on the merits.

Dated: March 8, 2024

SO STIPULATED:

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SO ORDERED this __ day of March, 2024.

WILLIAM C. BRYSON
UNITED STATES CIRCUIT JUDGE